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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/037,315      03/09/98      NELSON

S      744-P-4

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IM62/0523

EXAMINER

AHMAD, N

ART UNIT

PAPER NUMBER

1772

DATE MAILED:

05/23/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/037,315**

Applicant(s)  
**Nelson**

Examiner  
**Nasser Ahmad**

Group Art Unit  
**1772**



☒ Responsive to communication(s) filed on Feb 28, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 11-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 11-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1772

1. Applicant's arguments with respect to claims 11-20 have been considered but are moot in view of the new ground(s) of rejection.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shields (5,609,938) in view of Plourde (5,756,153).

Shields relate to a one-way, see through panel comprising a plastic substrate having a light colored first surface and a dark colored second surface. The substrate is perforated and has an ink image printed on the first surface using ink printing process. The dark surface includes pigmented adhesive with perforated release liner and an imperforated barrier thereover. The substrate can be polyvinyl. However, Shields fails to teach that the first surface is provided with ink jet receptive coating. Plourde discloses a plastic signage substrate provided with adhesive and release line on its back surface, and print receptive layer on its front surface. The print receptive coating can be customized based on the ink printing process. Plourde teaches the advantage of using ink jet receptive coating that are resin based to provide for processability with ink jet printers. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Plourde's teaching of using ink jet receptive coating in the invention of Shields.

Art Unit: 1772

As for the process of perforation, it is not germane to the issue of patentability of a product and hence, have not been given patentable weight.

4. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross (5,830,529) in view of Plourde.

Ross relates to a see - through panel with a light surface and an opposed dark surface. The see - through panel is perforated and provided with an adhesive backing (see figure - 33; col. 54, line 56 to col. 55, line 17). The panel substrate can be polyvinyl, polyester, etc. (col. 58, line 3). The panel surface is ink printed using, among other, ink-jet printing (col. 1, lines 42-53). However, Ross fails to teach the presence of an ink-jet receptive coating on the light surface. Plourde, as discussed above, teaches the advantage of using ink-jet receptive coating on the printable surface of a plastic substrate such as polyester for enhancing its use with ink-jet printers. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Plourde's teaching of using ink-jet receptive coating in the invention of Ross.

5. The affidavit under 37 CFR 1.132 filed February 28, 2000 is sufficient to overcome the rejection of claims 8-10 based upon 35 U.S.C. 102(b) over Shields.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Art Unit: 1772

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 11-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,925,437. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the patent '437 recites a one - way, see - through panel having the same structure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is (703) 308-4424. The examiner can normally be reached on Monday - Thursday from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ellis Robinson, can be reached on (703) 308-2364. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.


Application/Control Number: 09/037,315

Page 5

Art Unit: 1772

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Nasser Ahmad/om  
May 22, 2000

  
NASSER AHMAD  
PRIMARY EXAMINER  
~~GROUP 1300~~  
TC-1700